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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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10/642,602

08/19/2003

Fumio Futami

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EXAMINER

CURS, NATHAN M

ART UNIT

PAPER NUMBER

2613

MAIL DATE

DELIVERY MODE

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

| | | | |
|---|--------------------------------------|--------------------------------------|--|
| Advisory Action Before the Filing of an Appeal Brief | Application No. 10/642,602 | Applicant(s) FUTAMI ET AL. | |
| | Examiner NATHAN M. CURS | Art Unit 2613 | |

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 06 July 2009 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
- (a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ They raise the issue of new matter (see NOTE below);
- (c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
- The status of the claim(s) is (or will be) as follows:
- Claim(s) allowed: _____.
- Claim(s) objected to: 16.
- Claim(s) rejected: 1-7, 9-15, 18, 19.
- Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
12. ☐ Note the attached Information *Disclosure Statement*(s). (PTO/SB/08) Paper No(s). _____
13. ☐ Other: _____.

/NATHAN M CURS/
 Primary Examiner, Art Unit 2613

Continuation of 11. does NOT place the application in condition for allowance because: Applicant's proposed amendment corrects a typographical error and substitutes the language "positive integer equal to or greater than 3" for the language "positive integer greater than 2" in claim 1. This proposed amendment to claim 1 does not change the scope of the claim because the two phrases are equal. Thus the scope of the claims of the proposed amendment is the same as that of the finally rejected claims of 13 January 2009.

In the Remarks pages 7-9 regarding claim 1, Applicant argues that Kajiya and Griffin do not teach or suggest the "n is equal to or greater than 3" limitation. First, Kajiya is not relied upon for this limitation in the combination. Second, Applicant ignores the substance of Mikkelsen contribution in the rejection, where the limitation in question is read on after both the teaching of both Mikkelsen and Griffin are added to the combination. Applicant argues against figs. 9A and 9B and paragraph 0054 of Griffin, none of which play a role in the combination.

Regarding Griffin paragraph 0032, cited in the rejection, Applicant argues that Griffin "merely describes that an optical transmission versus drive voltage characteristics is cyclic so that regarding the use of the MZ optical modulator as an intensity modulator (optical gate), Griffin only discloses a situation where $n=1$ ". However, the statement "so that regarding the use of the MZ optical modulator as an intensity modulator (optical gate), Griffin only discloses a situation where $n=1$ " does not follow from the principle that an optical transmission versus drive voltage characteristic is cyclic as discussed by Griffin. Contrary to Applicant's additional assertion that Griffin's teaching does not suggest a doubled modulation factor, what follows from Griffin's teaching is that the transmittance (and non-transmittance) states of the gating behavior of the modulator is cycled through for increasing drive voltages (e.g. increasing modulation factor).

Further, Applicant's remarks do not address Mikkelsen's significant contribution to the obviousness of the $n=2$ or more limitation. It is the contribution of both Griffin and Mikkelsen that results in the obviousness of the $n=2$ or more limitation. Thus, Applicant's arguments against the obviousness rejection of the $n=2$ or more limitation are not persuasive.

In the Remarks page 9, regarding claims 18 and 19, Applicant simply asserts that the claimed features are not taught by the prior art without addressing any of the merits of the rejections; thus, this argument is not persuasive..